

## **REMARKS**

The Examiner's comments together with the cited references have been carefully studied. Favorable reconsideration in view of the following remarks is respectfully requested.

As explained below, submitted herewith is an accurate English language translation of the priority French Patent Application 0308848, filed July 18, 2003. As such translation is fully consistent with Applicant's previous assertions that the disclosure and claims of the present application essentially correspond to, and are thus fully supported by, the disclosure and claims in the priority application, no new issues are raised. As such translation and the further arguments presented below are believed to overcome all asserted rejections and thus place the application in condition for allowance, entry thereof is respectfully requested. Alternatively, as such translation clearly established that Applicant is entitled to full benefit of the claimed priority date, and thus in combination with the previously submitted Statement of Common Ownership remove the asserted Poncelet 35 USC 102(e) reference for use under 35 USC 103, entry of such translation after final is respectfully requested as placing the application in better form for appeal by reducing the number of issues to be considered on appeal.

Relying on 35 U.S.C. 102(e), the Examiner rejected claims 1-4 and 6-18 as being anticipated by Poncelet (WO/2004/009368). In response to Applicants' explanation that Poncelet does not anticipate the present claimed invention as Poncelet does not disclose an ink-receiving layer comprising at least one hydrosoluble binder and at least one hybrid aluminosilicate polymer obtainable by the steps recited in the present claimed invention and which also comprises inorganic particles as required by the present claimed invention (see last line of claim 1), the Examiner "counters" that the Applicant defines inorganic particles as including metal and metal hydroxide, and that Poncelet used metal hydroxides in the formation of the aluminosilicates. The examiner "takes the position" that some of the unreacted inorganic particles would remain in the proximity of the aluminosilicate in the ink receiving layer. Additionally, one of the sources of silanol groups used by Poncelet is from silica particles, and the Examiner "takes the position" that some of the silica

particle would also be present in the ink receiving layer. Reconsideration is strongly requested, as there is no support in the actual disclosure of Poncelet for such proposed “positions” so as to support a finding of anticipation, which requires that all the limitations of the claimed invention be necessarily disclosed in combination, rather than be just mere potential possibilities. Contrary to the Examiner’s position, it is in any event pointed out that the referenced use of sodium, potassium or lithium hydroxide in Poncelet refer to the use of aqueous solutions of such water soluble inorganic alkali salts in a reaction step for the preparation of the aluminosilicate polymer itself, rather than any distinct inorganic particles contained in an ink receiving layer, and that the referenced use of silica particles as a source of silanol groups similarly refers to a reactive component employed in the formation of the aluminosilicate polymer itself, rather than any distinct inorganic particle in an ink receiving layer. Again, the Examiner’s conjecture as to whether any of such particles might end up in the ink receiving layer (despite Poncelet expressly teaching various purification steps such as washing, successive sedimentation, diafiltration, centrifugation, nanofiltration, etc. in the preparation of the aluminosilicate polymer itself as described, e.g., at the bottom of page 8) does not equate to anticipation of the present claimed invention. Rather, contrary to the “position taken” by the Examiner, there is clearly no support for the allegation that Poncelet anticipates the present claimed invention

**The Advisory Action mailed November 30, 2009 asserts that the Examiner “maintains that Poncelet anticipates the applicants’ composition for the ink receiving layer with inorganic particles”, but does not address the above arguments as to lack of any disclosure in Poncelet that necessarily discloses all required claim limitations in combination so as to anticipate the present claimed invention, as opposed to the mere conjecture of possibilities proposed by the Examiner. Reconsideration of this anticipation rejection is accordingly again respectfully urged.**

Claim 5 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Poncelet and further in view of Liu (US 5,958,168). In response to Applicants’ filing of a Statement of Common Ownership at the time of the invention to prevent the use of the Poncelet 102(e) reference for use under 35 USC 103, the Examiner

asserts that the WO/2004/009368 publication of Poncelet has a 35 USC 102(a) date of 02 July 2004, and that Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of such priority papers has not been made of record in accordance with 37 CFR 1.55. Applicant has stated that the present application (with added Section Headings) and original claims 1-18 thereof is itself essentially an accurate translation of the priority specification and claims 1-18 thereof, which can be clearly verified by a corresponding paragraph by paragraph review of the submitted certified copy of the priority application and the present application.

**Despite such statement, the Advisory Action states that Applicant has not complied with MPEP 201.15 for the perfection of the foreign priority document. Submitted herewith is an English language translation of the priority French Patent Application 0308848, filed July 18, 2003. Such translation is an accurate translation. Such translation demonstrates that the disclosure and claims of the present application essentially correspond to, and are thus fully supported by, the disclosure and claims in the priority application, and that Applicant is accordingly clearly entitled to full benefit of the claimed priority date.** The asserted Poncelet 35 USC 102(e) reference is accordingly not available for use under 35 USC 103 in view of Applicants previously submitted Statement of Common Ownership. Reconsideration of such rejection in view of such submitted translation, statement of accurate translation, and benefit of claimed priority date, is accordingly respectfully urged.

Claims 1-10, 17, and 18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Liu (US 6,548,149). The Examiner states: Liu discloses an ink recording element formed on a substrate and including a binder and particles of silica prepared by wet method and/or aluminosilicate agglomerated with each other without binder (abstract); Liu further discloses that the aluminosilicate can be produced by subjecting a mixture containing, as principal components, aluminum alkoxide and silicon hydroxide for a hydrolysis (controlled) procedure, and are a complex product comprising alumina moieties and silica moieties which are closely combined with each other to such an extent that these moieties cannot be isolated from each other; usually, in the aluminosilicate particles, the alumina moieties ( $\text{Al}_2\text{O}_3$ ) and the silica moieties ( $\text{SiO}_2$ ) are contained in a weight ratio (Al/Si) of 1:4 to 4:1, preferably about

6:2 (column 9, lines 44-53); Liu also discloses the ink receiving layer contains specific silica and aluminosilicate colloidal particles (column 16, lines 66-67); the examiner “takes the position” that although Liu uses only *hydrolyzable* substituents on the silicon *or* aluminum compounds it would have been obvious to a person of ordinary skill in the art at the time of the invention to use hydrolyzable, non-hydrolyzable substituents or blend since it is well known in the art that the R group in  $RZ(OR')_3$ , (where Z = Si or Al) with more hydrocarbon character increases the affinity of a material toward organic medium; and the Examiner “takes the position” that Lui demonstrates that the preparation of aluminosilicate is conducted by hydrolysis and results in a specific ratio range relative to Al/Si. The Examiner concludes that one skilled in the art “would conduct such a synthesis to produce the desired ratio similar to the applicant” ; and Liu teaches the preparation of aluminosilicate and its use in ink receiving layers. This rejection is respectfully traversed.

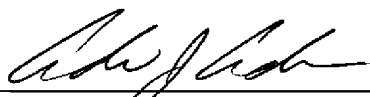
As now acknowledged by the Examiner, the present claims require use of a hybrid aluminosilicate polymer obtained by a specified preparation method by either treating a mixed aluminum and silicon alkoxide of which the silicon has both hydrolyzable substituents and a non-hydrolyzable substituent, or a mixed aluminum and silicon precursor resulting from the hydrolysis of a mixture of aluminum compounds and silicon compounds only having hydrolyzable substituents and silicon compounds having a non-hydrolyzable substituent, with an aqueous alkali, in the presence of silanol groups. The Examiner now alleges that the usage of hydrolysable, non-hydrolyzable substituents or blend thereof is well known in the art of aluminosilicate polymers. The Examiner provides no support for such mere allegation, however, and certainly no support for such allegation within the specific construct of the present claimed invention directed towards preparation of specific aluminosilicate polymers by a specific preparation method. To the contrary, as conceded by the Examiner, aluminosilicate polymers are complex products, and it accordingly would not be a simple or “obvious” matter to modify the prior art processes to provide new distinct materials with distinct properties. Use of such a hybrid aluminosilicate polymer obtained from silicon compounds having non-hydrolyzable substituents is clearly not taught or suggested by Liu et al., as such reference only disclose use of fully alkoxylated (i.e., all hydrolyzable groups) silicon

compounds in the preparation of the aluminosilicates thereof (see, e.g., use of ethyl orthosilicate at col. 23, line 15 of Liu et al). Thus, such aluminosilicate polymers themselves are clearly distinct, and Liu et al does not suggest the use of a hybrid aluminosilicate polymer in accordance with the present invention. Absent a specific teaching in the prior art to do so, the Examiner's mere speculation clearly does not establish a prima facie case of obviousness with respect to the present claimed invention.

**The Advisory Action mailed November 30, 2009 entirely fails to address Applicants' arguments above with regard to the mere allegations asserted by the Examiner, despite the clear lack of any support in the cited reference itself, and the acknowledgement that aluminosilicate polymers are complex products, such that it accordingly clearly would not be a simple or "obvious" matter to modify the prior art processes to provide new distinct materials with distinct properties in accordance with the present claimed invention. Reconsideration of this rejection is accordingly again respectfully strongly urged.**

In view of the foregoing remarks and amendment, the claims are now deemed allowable and such favorable action is courteously solicited. Should the Examiner consider that additional amendments are necessary to place the application in condition for allowance, the favor is requested of a telephone call to the undersigned counsel for the purpose of discussing such amendments.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.